IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.	:	10/713,503	Confirmation No.:	9958
Applicant	:	DUNFEE, Albert H.		
Filed	:	November 14, 2003		
TC/A.U.	:	3734		
Examiner	:	TRUONG, Kevin Thao		
Docket No.	:	P1190CIP		
Customer No.	:	28390		
Title	:	Intraluminal Catheter With Hydraulically Collapsible Self-Expanding Protection Device		

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

ARGUMENTS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The Appellant appeals the rejection of Claims 1-3, 5-17, 19-25 and 27-34 in the above-captioned application. These claims, as they appear in the Listing of Claims on pages 2-6 of the Amendment filed on May 9, 2005, were rejected in the Final Office Action dated May 31, 2005.

The following Arguments, beginning on page two (2), accompany the attached Pre-Appeal Brief Request for Review. No Amendments are being filed with these Arguments.

ARGUMENTS

Claims 1-3, 5-17, 19-25 and 27-34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,952,747 to Kimmel *et al.*, hereinafter "Kimmel." Appellants aver that this rejection under 35 U.S.C. § 102(b) is improper because Kimmel fails to describe, either expressly or inherently, each and every element as set forth in the claims. A claim is anticipated only if the elements are arranged as required by the claim. See MPEP 2131 and *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340.

Claim 1, as amended, requires in part

> a first tubular member comprising a hypotube having a proximal end and a distal end and having a fluid containing lumen therethrough; and
> a master actuating member configured for longitudinal movement within said hypotube proximate said proximal end. (Emphasis provided)

The rejection asserts that Kimmel's plunger 50 corresponds to the required master actuating member and is configured for longitudinal movement within hypotube member 22, 48. See Detailed Action mailed December 4, 2006, paragraph 2, lines 8-10 and final Detailed Action dated May 7, 2007, p. 3, lines 2-4. Appellants contend that the rejection mischaracterizes the teachings of the reference.

Kimmel's "syringe 48 is of conventional construction and includes a cylindrical barrel 49 having a plunger reciprocably mounted therein." See col. 6, lines 56-59 and FIG. 4, provided below for convenience. In the final rejection, at p. 3, lines 4-5, "Kimmel's tube 48 is considered a hypotube due to given its broadest reasonable interpretation."

Appellants aver that a conventional syringe and hypotub(ing) are two common, but clearly distinct articles in the field of medicine. Hypotubing was originally used to make relatively short hypodermic needles, *i.e.* for injections below (hypo) the skin (dermis). In recent decades, the elongate hypotube has become an ordinary raw material for making medical guidewires or guidewire-like medical devices for insertion into the

patient. The conventional syringe has been in use for over 150 years and is well known as a fluid-handling apparatus that is manipulated outside the patient's body. There is no need to "interpret" what a conventional syringe is; therefore, to consider a syringe a hypotube is unreasonable.

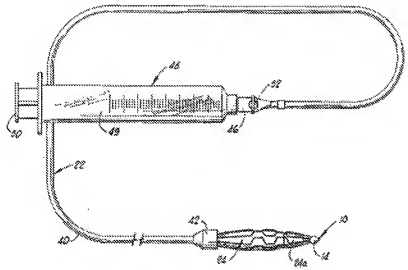

FIG. 4

In view of the above arguments and those of record in the application, claim 1 is patentable because Kimmel fails to teach all the elements of claim 1, arranged as required by the claim. Independent claims 15 and 24 are patentable for the same reasons that claim 1 is patentable because claims 15 and 24 have limitations comparable to claim 1 regarding a member for longitudinal movement within a hypotube. The dependent claims are patentable for the same reasons as their parent claims. While it is not necessary to address the rejections of the dependent claims at this time, appellants reserve the right to support their patentability, when necessary. In view of the above arguments, appellants request that the rejection of claims 1-3, 5-17, 19-25 and 27-34 rejected under 35 U.S.C. § 102(b) be withdrawn.

Respectfully submitted,

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
P1190 CIP	

Application Number	Filed
10/713,503	November 14, 2003

First Named Inventor:
DUNFEE, Albert H

Art Unit	Examiner
3734	TRUONG, Kevin Thao.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96).

☒ attorney or agent of record.
Registration Number 39,560

☐ attorney or agent under 37 CFR 1.34.
Registration number if acting under 37 1.34 _____

/James F. Crittenden/
Signature

James F. Crittenden
Typed or printed name

978.739-3075
Telephone number

July 2, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ Total of _____ forms are submitted.